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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/648,702

08/26/2003

Christopher Leger

2912-001

4046

42389

7590

02/22/2005

TIGHE PATTON ARMSTRONG TEASDALE PLLC  
PATENTS  
BOX 66148, WASHINGTON SQUARE STATION  
WASHINGTON, DC 20035

EXAMINER

HESS, DANIEL A

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 02/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/648,702	LEGER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Daniel A Hess	2876	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 January 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Remarks*

The applicant has made a 131 affidavit to indicate an earlier date of invention in order antedate the references applied 10/5/2004.

The examiner has found evidence that the Precision Forestry Cooperative (PFC) teaching cited in the First Action on the merits in this case actually has an earlier date than previously suggested. The Internet document was published no later than March 28<sup>th</sup>, 2001, which is almost a year prior to the earlier date provided by the 131 affidavit.

Regarding particularly the applicant's assertion that PFC is non-enabling, the examiner strongly disagrees and notes that embedding RFID tags in wood is (a) no difficult task for a carpenter of reasonable skill, and (b) taught in the form of wooden pallets having embedded RFID tags by Cybulski et al. (US 6,669,089).

Since the grounds of rejection have changed while the claims remained the same, this action is a second non-final rejection.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5, 7-13, 15, 16, 18 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by an Internet article from 3/28/2001 or earlier by the University of Washington Precision Forestry Cooperative entitled "RFID". The article will be hereinafter referred to as PFC. The Internet Archive, available at <http://www.archive.org> was used to establish a date for this article. The url <http://www.cfr.washington.edu/research.pfc/research/index.htm> was entered and the article included herewith is the contents of that url as of 5/17/2001, and the page indicates at the bottom that the most recent update of the page took place on 3/28/2001.

PFC teaches all of the elements and means as recited in claims 1-5, 7-13, 15, 16, 18 and 20. For example, PFC teaches the following:

Re claims 1, 15, 20: PFC teaches the following:

- An RFID tag is inserted into a tree, as is shown in the drawing.
- This tag is read by a reader.
- The tag contains information, namely an ID number.
- Since a stated goal is to track trees from seedlings, it is understood that at least one subsequent scan occurs, after the tag is inserted into the tree.
- Conservation easement is discussed, which falls in the category of forestry management.

Re claim 2: That the physiological impact on the tree is negligible is implicit in PFC. A purpose of the tagging is conservation; harming a tree would be in direct contradiction to this.

Re claim 3: This claim is very subjective; RFID tags generally are not large, so the visual mark from one would not be great.

Re claims 4 and 5: The figure of PFC shows the tag inserted into the trunk, near the base.

Re claim 7: The markers in PFC are described as being for a conservation easement, which constitutes an environmental assessment.

Re claim 8: PFC includes a discussion of 'database possibilities' in which a database associates an ID stored on the tag with information about that tree in a database, the database being clearly on a computer that is remote from the trees.

Re claim 9: 'Conservation easement' of PFC amounts to instructions on how to manage a tree.

Re claim 10-12: All of these aspects are incorporated in the discussion of 'database possibilities' in PFC.

Re claim 13: This is inherent in PFC: The scanning system reads the tag; this data must be interchanged with the database through some link.

Re claim 16: PFC explicitly describes the tag on the tree as passive.

Re claim 18: See discussion re claims 1 and 8, above.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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Claims 6, 19 rejected under 35 U.S.C. 103(a) as being unpatentable over PFC.

Re claims 6, 19: That tags are written to is not explicitly taught by PFC. Nevertheless, many smart tags have for a number of years been writable. For example, this examiner has known of a writable RFID tag for Metrorail transport since prior to the invention by the applicant.

In view of this, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the old and well-known writeability of Metrorail RFID systems in tree marking because conservation easements could change with changing politics and laws.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over PFC in view of Cybulski et al. (US 6,669,089).

PFC is used to track trees, but does not teach that a scanner is mounted on a vehicle.

Cybulski et al. teaches (figure 7 is exemplary) a series of interrogators 280 mounted on a forklift 290 for interrogating that which the forklift is transporting. Such interrogators could certainly interact with RFID transponders in lumber that is being carried.

In view of Cybulski et al.'s teachings, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include an interrogator on a vehicle because this conveniently allows a worker to more quickly handle wood and trees than he/she would be able to on foot.

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Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over PFC in view of Mosher, Jr. (US 5,973,600).

PFC's system is passive.

Many tags, including Mosher, Jr.'s (see abstract) can be in either passive or active mode.

In view of Mosher, Jr.'s teaching, it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the old and well-known active transponder means because an active transponder can yield a stronger signal and greater range.

### ***Response to Arguments***

The applicant has suggested that PFC may be non-enabling. The examiner respectfully but strongly disagrees, because what PFC does is well within the capability of basic RFID tags and readers, basic database technology and basic carpentry. Indeed all three of these basic technologies are more than ten years old.

### ***Conclusion***

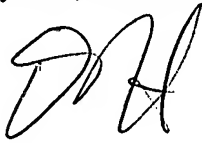
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel A Hess whose telephone number is (571) 272-2392. The examiner can normally be reached on 8:00 AM - 5:00 PM M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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